

REMARKS

By this amendment, claim 20 has been amended, and claim 22 has been cancelled. Claims 1-13, 20-21, and 23-24 remain for consideration in the application.

Claim Rejections Under 35 U.S.C. § 112

Claims 20-22 were rejected under 35 U.S.C. § 112, second paragraph. Claim 20 has been amended to overcome the rejection.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-9 and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rubens (U.S. Patent No. 4,965,948). Applicant again traverses.

The Office Action dismisses Applicant's reasoned argument about the applicability of *In re Gulack* with a blanket statement that "the examiner disagrees" without providing any response to the specific arguments of Applicant. Those arguments are repeated herein:

The claim is directed to a guidebook for taking pictures. The information about where the pictures are to be taken and the parameters for the taking of the pictures is the printed matter. All the elements are assembled into a book that is used by a photographer to generate a series of pictures. The printed matter is clearly functional. In contrast, Rubens is a blank photo album. The writing surfaces are blank. There is no guide function to the Rubens album. It is a shell into which photos are placed, and there is no information appearing in the blank album about photos until it is entered by a user or consumer. The claims must be read in view of the specification, which makes it clear about the functional relation between the book and the descriptions.

In re Gulack held:

A functional relationship of the precise type found by the CCPA in *Miller* — to size or to type of substrate, or conveying information about substrate — is not required. What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. (*See In re Gulack*, 217 USPQ 401, emphasis in original).

In re John Ngai and David Lin interpreted *Gulack*, holding “In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result.” (*In re John Ngai and David Lin*, 367 F.3d 1336, CAFC 2004). In the present claims, the same application holds true. Without the printed matter, the photo pages could not achieve their purpose of holding specific photos identified and detailed in the printed matter, and without the photo pages, the instructions and the arrangement of the book could not achieve their purpose. In this manner, it is also clear that there is a functional relationship between the printed matter and the substrate. The printed matter and the blank photograph locations of the present claims are interrelated, so as to produce a new product useful for educational and recreational mathematical purposes.

Claims 1, 7, and 20 each contain elements not present in *Ruebens*, and elements not obvious in view of *Ruebens* given *In re Gulack* as stated, and as interpreted by *In re John Ngai and David Lin*, and as such no prima facie case of obviousness has been shown. Claims 1, 7, and 20 are allowable. Claims 2-6, 8-9, and 21-22 depend from and further define one of patentably distinct claims 1, 7, or 20, and are also believed allowable.

Claims 10-13 and 23-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sussman et al.* (U.S. Patent No. D468,350 S) or *Smith* (U.S. Patent No. 6,257,621 B1) in view of *Rubens* (U.S. Patent No. 4,965,948). Applicant traverses.

The analyses of *In re Gulack* and *In re John Ngai and David Lin* above applies equally well to claims 10 and 23. Each of claims 10 and 23 contain the same interrelation of printed matter and substrate that renders the argument of the Office Action under *In re Gulack* moot since *Ruebens* does not meet the holding outlined in *In re Gulack* as stated, and as interpreted by *In re John Ngai and David Lin*, and as such no prima facie case of obviousness has been shown. Claims 10 and 23 are allowable. Claims 11-13 and 24 depend from and further define one of patentably distinct claims 10 or 23, and are also believed allowable.

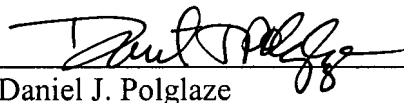
CONCLUSION

In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No.08-2025.

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2203.

Respectfully submitted,

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